

35



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,426	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.732	5220

25883 7590 05/06/2003

HOWISON, THOMA & ARNOTT, L.L.P  
 P.O. BOX 741715  
 DALLAS, TX 75374-1715

EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/382,426

**Applicant(s)**

PHILYAW ET AL.

**Examiner**

Tim Brown

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2003 (Paper 16) has been entered.
2. Claims 1-27 have been examined.

### ***Response to Arguments***

#### Claims 1 and 14

3. Applicants argue Reber et al. do not disclose how the profile information of the user is processed prior to and during the transaction. Paper 16, p. 7. This argument is moot in view of the new ground of rejection under Light et al. (US 6,192,380).
4. Applicants further argue Reber et al. fail to teach extracting user profile information from a second location. Paper 16, p. 7. The Examiner respectfully disagrees. Reber et al. approves online transactions based upon a "second data element" which represents the party to a transaction. Col. 3, lines 57-60. Reber further provides the "second data element can be *prestored in the network access apparatus* or can be generated by a code generator associated with the network access apparatus." Col. 4, lines 21-27. Consequently, Reber teaches extracting user profile information from a second location.

5. Applicants also suggest Reber fails to teach "sending profile information *to the vendor* location for the purpose of inserting the profile information into a form for viewing by the user . . . ." Paper 17, p. 8 (emphasis original). However, this argument is moot in view of the new ground of rejection under Light et al..

Claims 7-9 and 20-22

6. Applicants argue Wong fails to teach causing "*all the profile information to be entered into the vendor payment form* as encoded information." Paper 17, p. 8 (emphasis original). Applicants reasoning is based on two assertions. The first assertion holds that claim 7 is directed to the vendor automatically entering all of the user profile information. Applicants second assertion is that Applicants' use of encoded "simply means converting information to a different form . . . ." Id at 9.

Regarding the first assertion, the Examiner notes Wong has not been offered for teaching having the vendor enter the user's profile information into the payment form. Rather, the combination of Reber et al. and Light et al. has been offered as teaching this feature. See rejection of claim 7 *infra*. Regarding Applicants' second assertion, Applicants state encoding is merely the practice of converting data from one form to another and that encryption mean performing changes in which data is "securely encoded." Id. Wong teaches *encrypting* a user's personal information including name, address, telephone and credit card numbers. Col. 3, lines 38-62. Therefore, Applicants admit Wong teaches encoding the user's profile information.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

Art Unit: 3625

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the teachings of Reber et al. and Wong is derived from gaining the advantage of Internet security.

Claims 10 and 23

8. Applicants arguments regarding claims 10 and 23 are moot in view of the new grounds of rejection under Light et al..

Claims 11, 12, 24 and 25

9. Applicants argue claims 11 and 24 are distinguishable from Gardenswartz (US 6,055,573) because Gardenswartz's database is a distinct and separate structure from the registration server. Paper 17, p. 9. However, the Examiner notes claim 11 recites that "*the second location* is a central server having a database . . . ." (Emphasis added). Consequently, Gardenswartz teaches the limitations of claims 11 and 24.

10. Applicants further argue Gardenswartz fails to disclose "a central registration server having a database of the profile information associated with respective unique barcodes and unique ID numbers." Paper 17, p. 10. However, the Examiner notes Reber teaches associating profile information with respective unique barcodes. See col. 3, lines 57-60. Hence, Gardenswartz has only been offered for its teaching of a

second location having a central server database which is disclosed in Fig. 1.

Consequently, Gardenswartz overcomes the alleged deficiencies of Reber et al..

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**12. Claims 1-6, 13-19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767), Light et al. (US 6,192,380) and Official Notice.**

Regarding claims 1 and 14, Reber et al. teach a method and system of processing profile information of a user for conducting an on-line transaction wherein the system provides the method comprising the steps of: entering profile information of a user into a computer at a user location disposed on a network (col. 1, lines 36-45); issuing a bar code in response to the user transmitting the profile information from the user location to a second location, the second location disposed on the network (col. 2, lines 24-30; and col. 4, lines 14-27); providing the bar code for purchase of a product of a vendor location disposed on the network, during the on-line transaction (col. 2, lines 24-30; col. 3, lines 57-59; and col. 5, lines 4-15); providing the profile information from the second location to the vendor location in response to the vendor location processing the bar code (col. 5, lines 4-32); and automatically inserting the profile information into a vendor payment form for presentation to the user (col. 10, lines 44-49).

Reber et al. do not specifically teach having the user enter profile information into a form. However, the examiner takes Official Notice that using a form to collect user

information over the Internet was notoriously well-known in the Internet commerce art at the time of the applicant's invention. Therefore, it would have been obvious to one having ordinary skill in the Internet commerce art, to combine the teachings of Reber et al., to include the use of a form in order to provide a formatted questionnaire that is directed at obtaining specific information.

The combination of Reber et al. and well known principles in the art do not expressly teach "providing the bar code for purchase of a product of a vendor location disposed on the network, during the online transaction, *which on-line transaction requires the user to view a vendor payment for representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the profile information of the user and which must be viewed by the user prior to completion of the online transaction.*"

However, Light et al. teach a method and apparatus for automatic web form fill-in. According to Light et al., user data is collected from a database and automatically inserted into an online form (Abstract; col. 1, lines 45-46; col. 3, lines 47-65; and col. 4, lines 1-25). The form is then presented to the user in order to allow the user to fill in any blanks (col. 4, lines 15-24). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Reber et al. to include requiring the user to view a vendor payment form as recited in claim 1. This combination would allow Reber et al. to collect other information required for the completion of an online transaction. For example, a user may want to indicate a particular mode of shipping or a different delivery address.

Art Unit: 3625

Regarding claims 2 and 5, Reber et al. further teach a method and system wherein the user fills in the form only one time (col. 1, lines 36-45).

Regarding claims 3 and 16, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. also teach a method and system wherein the user profile information is transmitted to the second location over a public switched telephone network. Reber et al. et al. do not specifically teach the use of a form for transmitting the user profile information. However, the examiner takes Official Notice that, at the time of the applicant's invention, the use of a form was well-known in the Internet Commerce art as discussed under claims 1 and 14 above.

Regarding claims 4 and 17, Reber et al. further teach a method and system wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the bar code to the second location (col. 5, lines 4-32).

Regarding claims 5 and 18, Reber et al. further teach a method and system wherein the bar code is unique and has a unique ID number associated therewith (col. 1, lines 36-45; col. 2, lines 24-32; and col. 4, lines 14-20).

Regarding claims 6 and 19, Reber et al. further teach a method and system wherein the user provides the unique ID number to the vendor location for payment purposes (col. 1, lines 36-45).

Regarding claims 13 and 26, Reber et al. further teach a method and system wherein the bar code is placed on a credit card (col. 6, lines 41-67; col. 7, lines 1-18; and Fig. 2).



**13. Claims 7-9 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Wong et al. (US 5,956,699).**

Regarding claims 7 and 20, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes all the profile information to be entered as encoded information. However, Wong et al. teach having a user encrypt his personal information, including name, address, telephone and credit card numbers before transmitting them through the Internet (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the use or encryption as taught by Wong et al., in order to prevent the unauthorized use of the user's personal information.

Regarding claims 8 and 21, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes only a portion of the profile information to be entered into the vendor payment form as encoded information. However, Wong et al. teach that a user may encrypt only his vital personal information (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because limiting the use of encryption would decrease the amount of

processing required to decode the user's profile information. Consequently, limiting the use of encryption would decrease the overall time required to process the user's profile information.

Regarding claims 9 and 22, Reber et al. teach all the limitations discussed under claims 8 and 20 above. Reber et al. do not specifically teach a method or system wherein the portion of encoded profile information is credit information. However, Wong et al. teach that a user may elect to encrypt his credit card number (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because encrypting only the user's credit information would limit the amount of processing required to decode the user's profile information. Thus, by reducing the amount of processing required to decode the user's profile information, the overall time required to process the user's profile information is reduced.

**14. Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Green et al. (US 5,664,110).**

Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein the user profile information comprises name, address, ship-to address and credit information. However, Green et al. teach providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information (col. 5, lines 22-42). Therefore, at the time of the applicant's invention, it would have been obvious

to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al., to include the teachings of Green et al. because providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information would eliminate the need for the user to submit this information every time he placed an order with the vendor. This would be particularly advantageous in cases where the user submits multiple orders to the vendor.

**1. Claims 11, 12, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Gardenswartz et al. (US 6,055,573).**

Regarding claims 11 and 24, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. inherently teach a database of profile information associated with unique bar codes. Reber et al. disclose that a user is identified by having the system read a unique bar code (col. 3, lines 56-67; and col. 4, lines 1-4). The system in Reber et al. must store identifying information that is associated with the unique bar code in order for a user to be identified by bar code. Therefore, a database of profile information associated with unique bar codes is inherent to the teachings of Reber et al.

Further regarding claims 11 and 24, Reber et al. do not specifically teach a method or system *wherein the second location is a central registration server* having a database of profile information associated with respective unique bar codes and unique ID numbers. However, Gardenswartz et al. teach a remotely-located registration server programmed to receive, store and/or transmit various types of information, including

Art Unit: 3625

identifying information (col. 6, lines 54-62; and Fig. 1). The database is inherent to the teachings of Gardenswartz et al. because the registration server is programmed for the storage of information (Id.). At the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Gardenswartz et al. because the addition of a central registration server that is capable of storing and transmitting identifying information would provide a system wherein the user could provide his profile information to a number of vendors while submitting this information to the registration server only once.

Regarding claims 12 and 25, Reber et al. teach all the limitations discussed under claims 11 and 24 above. Reber et al. do not specifically teach a method or system wherein the second location is a credit card company server. However, the examiner takes Official Notice that, at the time of the applicant's invention, submitting a user's profile information to a credit card company server was notoriously well-known in the Internet commerce art. Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include submitting a user's profile information to a credit card company server because this would allow the user to electronically apply for a credit card.

Art Unit: 3625

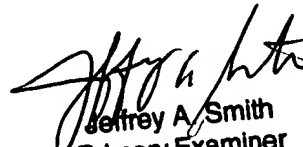
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown  
Examiner  
Art Unit 3625

TB  
May 5, 2003

  
Jeffrey A. Smith  
Primary Examiner